



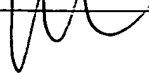
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,698	10/17/2000	Guy Nathan	871-95	1505
23117	7590	12/07/2004	EXAMINER	
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714			JONES, SCOTT E	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/688,698	Applicant(s) NATHAN ET AL. 	
	Examiner Scott E. Jones	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 and 15-19 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 12 and 15-19 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 25 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3713

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on August 12, 2004 in which applicant amends claims 12 and 19 and responds to the rejection to claims 12, 15, and 19 under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (U.S. 5,848,398) in view of Johnny Rockets Name That Tune. Claims 12 and 15-19 are pending.

Drawings

2. In order to avoid abandonment, the drawing informalities noted in the paper mailed on February 18, 2004, must now be corrected. Correction can only be effected in the manner set forth in the above noted paper. Although the examiner approved the correction to the drawing, a replacement drawing sheet including the correction is required. See 37 C.F.R. 1.121(d).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (U.S. 5,848,398) in view of Johnny Rockets Name That Tune.

Martin et al. discloses a method and apparatus for managing a plurality of computer jukeboxes at different locations from a remote central station. The remote central station maintains a host computer having a master library of songs stored in a bulk storage unit and each "jukebox" maintains a subset song library of the master library of songs. Each jukebox is updated with new songs and menus by simply downloading the data via a transmission link. Furthermore, in one

Art Unit: 3713

embodiment, the computer jukebox is associated with an electronic game. Martin et al. additionally discloses:

Regarding Claims 12 and 19:

- a remote server (central management system (11)) and at least one terminal (jukebox #1..jukebox #N (13)) operable to communicate with the server over a communications network, wherein the terminal (jukebox) includes an audio system (127, 129, and 131) for playing in connection with a game (electronic game) at least a portion of a musical recording (Abstract, Figures 1, 4A, 4B, 5, Column 1, line 66-Column 2, line 51, and Column 3, line 15-Column 4, line 40, and Column 9, lines 38-42);
- the terminal is a jukebox system that includes a storage device (93) that stores a library of musical recordings (91) that can be played in full on the terminal for a fee (Figure 5), and further wherein the library of musical recordings can be updated with additional musical recordings through communication with the server, thereby defining a customized library of musical recordings on the jukebox system (Abstract, Figure 1, 4, 5, Column 1, line 66-Column 2, line 51, Column 3, line 15-Column 4, line 40, Column 4, lines 58-63, Column 5, lines 40-57, Column 6, lines 8-18, Column 6, lines 45-52, and Column 7, lines 39-57).

Martin et al. seems to lack explicitly disclosing:

Regarding Claims 12 and 19:

- a display that displays information in the form of a question and suggests multiple choice answers to the question, wherein the question relates to the portion of musical recording that has been played, a user interface that enables a user to select an answer from the displayed multiple choice answers, and a scorer for recording the answer selected by the user and determining if the answer corresponds to a correct answer; and

Art Unit: 3713

- further wherein the jukebox system is operable to dynamically select the musical recording for the game from the customized library of musical recordings and to dynamically generate the question for the game based on the contents of the customized library of musical recordings stored on the jukebox system.

Regarding Claim 15:

- the terminal sends information to the server regarding how the user performed during the game.

Johnny Rockets Name That Tune teaches of a Name that Tune game that is played over a network, such as, the Internet. Johnny Rockets Name That Tune and Martin et al. are analogous art because each are computerized game systems that are associated with music played on jukeboxes. Johnny Rockets Name That Tune, however, seems to lack explicitly disclosing playing a song for a fee.

Johnny Rockets Name That Tune teaches:

Regarding Claims 12 and 19:

- a display that displays information in the form of a question and suggests multiple choice answers to the question (questions 1-5), wherein the question relates to the portion of musical recording that has been played, a user interface (Web page and player personal computer mouse and keyboard) that enables a user to select an answer from the displayed multiple choice answers, and a scorer for recording the answer selected by the user and determining if the answer corresponds to a correct answer (How Did I Do?); and
- further wherein the jukebox system is operable to dynamically select the musical recording for the game from the customized library of musical recordings and to dynamically generate the question for the game based on the current contents of the

customized library of musical recordings stored on the jukebox system. Merriam-Webster's Collegiate® Dictionary, Tenth Edition, defines dynamically as marked by continuous and productive activity or change; or of random-access memory: requiring periodic refreshment of charge in order to retain data. The examiner submits any computer, including any computer storing the Johnny Rockets Name That Tune game, contains random-access memory that obtains periodic refreshment of charge in order to retain game data. Additionally, the examiner asserts the process of creating (programming, generating, configuring) the Johnny Rockets Name That Tune game and the actual playing of the Johnny Rockets Name That Tune game is a dynamic process. The music numbers 1 (Leader of the Pack), 2 (Great Balls of Fire), 3 (That'll be the Day), and 4 (The Wanderer) are dynamically displayed and played in a sequence in time as the game is played. The process of playing the game is a dynamic process, not a static one. Furthermore, regarding the current contents of the musical library, the Johnny Rockets Name That Tune game can only be played with the data stored in the memory at that point in time. Therefore, the contents in memory are the current contents of the musical library. Furthermore, Martin et al. discloses updating the musical recordings via communication with a server.

Regarding Claims 15 and 19:

- the terminal sends information to the server regarding how the user performed during the game (How Did I Do?).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate Johnny Rockets Name That Tune game in Martin et al. One would be motivated to combine Martin et al. with Johnny Rockets Name That Tune because the

Art Unit: 3713

Johnny Rockets Name That Tune game is entertaining and would provide an additional source of profit for Martin's computer jukebox system when in the game mode.

5. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnny Rockets Name That Tune in view of Tom & Liz's Name That Tune.

Johnny Rockets Name That Tune teaches that as discussed above regarding Claims 12, 15, and 19. Johnny Rockets Name That Tune seems to lack explicitly disclosing a ranking system to rank player's performance.

Tom & Liz's Name That Tune, like Johnny Rockets Name That Tune is a computer/network-based name that tune game. Tom & Liz's Name That Tune shows:

Regarding Claim 16:

- the server collects game performance information for a plurality of different users and ranks the users according to their performance (pp. 4 and 5 of 10).

Regarding Claim 17:

- the server is operable to send user-ranking information to the terminal, and the terminal is operable to display ranking information.

Regarding Claim 18:

- the system includes a plurality of said terminals (each player's personal computer having an Internet connection) at different locations (players live in a plurality of states), each of the terminals being operable to communicate with the server, and further wherein the server is operable to collect performance information on users who play the game at any of the terminals to send user ranking information to each of the terminals.

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate the player performance ranking system of Tom & Liz's Name

Art Unit: 3713

That Tune game in Johnny Rocket's Name That Tune game. Providing a display of player rankings for games or game tournaments is notoriously well known to one of ordinary skill in the gaming art. Doing so motivates a game player to perform well and enables players to size up the competition.

Response to Arguments

6. Applicant's arguments filed August 12, 2004 have been fully considered but they are not persuasive.

7. Applicants do not agree with the rejection to claims 12, 15, and 19 under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (U.S. 5,848,398) in view of Johnny Rockets Name That Tune. Applicant alleges the examiner has not established a prima facie case of obviousness because there is allegedly no teaching or suggestion in Johnny Rockets Name That Tune game of the feature of dynamically generating the musical recording for the game from the customized library of musical recordings and dynamically generating the question for the game based on the contents of the customized library of musical recordings. The examiner respectfully disagrees and believes the combination of Martin and Johnny Rockets Name That Tune taken as a whole teaches these features to one having ordinary skill in the art at the time Applicant's invention. Furthermore, as discussed above, Merriam-Webster's Collegiate® Dictionary, Tenth Edition, defines dynamically as marked by continuous and productive activity or change; or of random-access memory: requiring periodic refreshment of charge in order to retain data. The examiner submits any computer, including any computer storing the Johnny Rockets Name That Tune game, contains random-access memory that obtains periodic refreshment of charge in order to retain game data. Additionally, the examiner asserts the process of creating (programming, generating, configuring) the Johnny Rockets Name That Tune game and the actual playing of the Johnny Rockets Name That Tune game is a dynamic process. The music numbers 1 (Leader of the Pack), 2 (Great Balls of Fire), 3 (That'll be the Day),

Art Unit: 3713

and 4 (The Wanderer) are dynamically displayed and played in a sequence in time as the game is played. The process of playing the game is a dynamic process, not a static one. Furthermore, regarding the current contents of the musical library, the Johnny Rockets Name That Tune game can only be played with the data stored in the memory at that point in time. Therefore, the contents in memory are the current contents of the musical library. Furthermore, Martin et al. discloses updating the musical recordings via communication with a server. Therefore, the rejection to claims 12, 15, and 19 under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (U.S. 5,848,398) in view of Johnny Rockets Name That Tune renders the claimed invention obvious.

8. Regarding the rejection to claims 16-18 under 35 U.S.C. 103(a) as being unpatentable over Johnny Rockets Name That Tune in view of Tom & Liz's Name That Tune, Applicants' acquiesce to the rejection applied to the claims under 35 U.S.C. 103(a) as being unpatentable over Johnny Rockets Name That Tune in view of Tom & Liz's Name That Tune by virtue of not addressing the rejection. Therefore, the rejection to claims 16-18 under 35 U.S.C. 103(a) as being unpatentable over Johnny Rockets Name That Tune in view of Tom & Liz's Name That Tune renders the claimed invention obvious.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 3713

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (571) 272-4438. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones
Examiner
Art Unit 3713



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